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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 1367

UNITED STATES PLYWOOD CORPORATION,
Cross-Petitioner,
v.
GENERAL PLYWOOD CORPORATION,
Cross-Respondent,

ON CROSS PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR CROSS-RESPONDENT IN OPPOSITION

OPINIONS BELOW

The Opinion of the District Court[1] (R 41a) is reported at 230 F. Supp. 831. The Opinion of the Court of Appeals as amended by that Court following a petition for rehearing[2] is printed in the Appendix to the Petition in Docket

[1] The District Court decision is not printed in the subject Cross-Petition (Docket No. 1367), but appears at p. 33 of the petition in Docket No. 1351.

[2] The Petition for Rehearing is not printed in the subject Cross-Petition (Docket No. 1367), but appears at page 61 of the petition in Docket No. 1351.

No. 1351 at p. 46 and is reported at 370 F. 2d 500. That Opinion, as it appeared *prior* to that amendment, is printed at SA-8 in the subject Cross-Petition. The amending order is printed in the Cross-Petition at SA-24.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

In addition to the relevant ones of the statutes and rules cited in the Cross-Petition, this case further involves the following:

66 Stat. 797, Title 35, U.S.C., "Chapter 10—Patentability of Inventions", Section 100, "Definitions".

> "When used in this title unless the context otherwise indicates * * *
>
> "(b) The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."

66 Stat. 798, Title 35, U.S.C., "Chapter 11—Application for Patent", Section 112, "Specification".

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

66 Stat. 800, Title 35, U.S.C., "Section 120. Benefit of earlier filing date in the United States."

"An application for patent for an invention disclosed in the manner provided by the first paragraph of Section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application."

Title 37, Part 1, "Code of Federal Regulations, Section 1.2 Business to be transacted in writing."

"All business with the Patent Office should be transacted in writing * * *. The action of the Patent Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promises, stipulation, or understanding in relation to which there is disagreement or doubt."

STATEMENT OF THE CASE

The statement in the Cross-Petition omits facts which show that the stated Questions are not actually raised by the facts of the case and the stated Questions assume facts not supported by the record. Accordingly, the following amplification is necessary.

This action was initiated by a Complaint filed by United States Plywood Corporation asking for a declaratory judgment that the patent to George E. Alexander No. 2,827,935 (R 3056a), "and each and every claim thereof is invalid and void and that plaintiff's products and plaintiff's processes do not infringe said patent or any claim thereof" (R 22a). General Plywood Corporation, owner of the patent, counterclaimed for infringement and for breach of trust (R 26a).

There was extensive discovery over a period of years, including discovery by United States Plywood on the issues of the validity and enforceability of the patent. There was a lengthy (40 day) trial during which United States Plywood Corporation opened as declaratory judgment plaintiff and introduced evidence relating to at least twenty-eight different grounds on which the patent was alleged to be invalid or unenforceable. The District Court for the Western District of Kentucky adjudged that the patent was valid and enforceable but not infringed (R 50a). Both parties appealed (R 51a-2a). The issues, including the issue of validity, were fully briefed and argued, and the Court of Appeals for the Sixth Circuit affirmed.

General Plywood Corporation timely filed, on May 4, 1967, a Petition for a Writ of Certiorari, Docket No. 1351. Four days later United States Plywood Corporation filed the subject Cross-Petition, Docket No. 1367.

Background of The Invention

In the words of the Court of Appeals (Cross-Petition p. SA-9):

> "These appeals represent the culmination of a bitter controversy between a giant member of the plywood industry and a somewhat smaller competitor.
>
> "United States Plywood is the biggest of American plywood manufacturers. General Plywood is a substantial manufacturer of plywood doors based in Louisville, Kentucky. At the relevant times in this record the whole industry was adversely affected by the entrance into the United States market of Japanese plywood imports. And at the time also more plywood panels were being sold in factory finished form for interior use in housing and office building.
>
> "The industry prepared such panels for factory finishing (or for sale to the construction industry unfinished) by running the panels through a series of machine sanders (usually three). The first such machine employed a rough sandpaper of 1/0 grit; the next two were progressively finer. It appears that the finest in general use by the industry at this stage, prior to the event we deal with, was 4/0 grit.
>
> "This sanding produced plywood panels ready for finishing and termed in the industry 'wood in the white.' The surface while relatively smooth was porous, somewhat fibrous, absorptive and without gloss or sheen.

"Subsequently, to change all these surface characteristics, finishing required filler, stain, lacquer and polishing."

Thus the panels were sanded to cut the major roughness away, followed by a finishing process to coat and protect the surface. However, the sanded wood surface (even though it was "fine" sanded) was porous, and, moreover, was of variable porosity from spot to spot. As a result, the lacquer which was applied to create a finish coating, was not only absorbed into the wood but was unevenly absorbed so that the wood industry was required to apply sufficient lacquer (normally in the form of several coats) to build a uniform coating (R 553a; 1543a; 1575-82a; DX 2093, R 3568a, 1775a-6a; DX 2056, R. 3493a-4a, 1447a). Moreover, it was necessary in prior practice to sand lightly between coats of finishing materials to remove the "nibs" or partially loosened fibers which raise through the coating (R 346a-7a; DX 2056, R 3455a-6a, 1447a; 2085a, 96a-7a).

The patented "microseal" process is an additional process performed after all steps of the sanding process are completed and before the normal finishing process is started. It serves to render the sanded wood surface smoother and less porous and to semi-permanently bond the nibs to the surface by the momentary and uniform application of frictional heat and pressure so as to simplify, improve and reduce the cost of finishing the wood. The frictional rubbing of the wood surface heats a thin surface layer of the wood to a temperature at which it is softened, without heating the underlying wood, so that the pressure exerted by the frictional rubbing medium can compress the heated surface layer without compressing the underlying wood. This result is achieved while the wood panels

are moving continuously along a conveyor line at a feed rate in the order of 90 feet per minute. The rubbing treatment is confined to a stationary zone in the form of a narrow band extending entirely across the flat wood surface transversely to the direction of travel. As a result, the length of the treatment for any given spot on the surface is only a fraction of a second. This confines the frictionally generated heat to an exceedingly thin layer from which the heat is almost instantly dissipated when the wood passes out of contact with rubbing medium, thereby permitting the compressed wood to stabilize (R 1414a-1420a, 1430a-32a and PX 1052, 3056a-62a).

The frictional rubbing medium which frictionally heats and pressure smooths the wood must, in use, be *relatively non-abrasive,* to produce the frictional heating and to avoid cutting off or wearing away the compressed surface layer as it is formed, and it must be heat insulating so that it will not conduct away the frictional heat as fast as it is generated. According to representative claim 7 (R 3061a), it must also be flexible, endless and yielding, as used. There are no other essential requirements. In accordance with the Patent Statutes,* the specification sets forth "the best mode contemplated by the inventor for carrying out his invention". It recommends the use of a cork belt as the rubbing medium, but the rubbing medium does not have to be "cork", as the specification clearly teaches (R 3058a), and none of the claims is so limited.

Similarly, in accordance with the statutory requirements, the patent illustrates and describes (R 3056a-60a) a suitable *machine* which can be used in practicing the process.

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*35 U.S.C. 112.

The illustrated machine is known as a "wide belt" machine having an adequate range of adjustments to permit the operating conditions to be correlated as taught in the patent to achieve the beneficial results which flow from the practice of the process.

The addition of the microseal process intermediate the commercial wood sanding and finishing operations entails an additional procedure and an additional investment in equipment (R 1200a; DX 2056, R 3468a, 3485a and 3487a, 1447a). Despite that fact, the resulting improvement in the final appearance and saleability of the finished wood products and the reduction in the total cost of manufacture have been such as to lead to widespread commercial adoption of the process. As the Court of Appeals correctly held:[4]

> "The Alexander process was both new in the industry and of great commercial value".

The process was practiced by General Plywood and the improvement in its products saved General Plywood's business when it was threatened by a business slump and severe import competition (R 1238a, 1895a; 2077a-8a). A number of manufacturers practiced the process under license from General Plywood (R 3611a; 2032a-34a). The process was industry-wide in its impact (DX 2056, R 3518a and 3520a-1a, 1447a), and was deemed "revolutionary" by the manufacturer of the "Timesavers" wide belt machines used by both parties (U.S. Plywood's witness Pendergast, DX 2022, R 3358a, 1219a). A Vice President of Carborundum Company, one of the largest suppliers of coated abra-

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[4] Cross-Petition, p. SA-18.

sives to the woodworking industry, similarly characterized the process (PX Carbo 89, R 2384a, 1184a, DX 2170, R 3661a-2a, 2188a) and his top technical expert testified that it had "revolutionized the plywood and door industry in the United States" and that the process had been of "great help in fighting off the extremely serious threat of imported plywood without which the situation for U.S. manufacturers would be many times worse than it is" (R 1888a-9a).

One of the "novel features" of the process which had led to its widespread adoption was characterized by the Court of Appeals as follows (Appendix to Cross-Petition p. SA-18):

> "The employment of relatively high speeds and pressures correlated to achieve the impact of heat just below scorching helped to achieve a surface smoothness, density and gloss in one machine operation which made subsequent finishing operations substantially simpler and less expensive".

The noted reduction in cost of finishing operations resulted from the fact that the process eliminated the need for at least one finishing coat of lacquer and related treatments (DX 2056, R 3487a and 3493a-4a, 1447a; DX 2028, R 3365a-6a, 1245a; 1927a-34a; DX 2093, R 3568a, 1576a; 1575a-82a).

The Judd Patent is Not Prior Art

United States Plywood Corporation asks this Court to review, on the merits, the concurring determinations of the Courts below that the Alexander patent in suit is valid. It frames its request as Questions designed to portray allegedly important, fundamental and appealing issues of law. The pretext that the Questions 2 and 3 are raised by the facts of this case is based largely on the contention that the Judd patent 2,765,598 (R 3067a) must be treated as "prior art" notwithstanding the concession that it has a later effective filing date than the Alexander patent in suit,[5] and the further concession that "petitioner does not claim on this petition that Judd was the prior inventor of the process claimed in the Alexander patent" (Cross-Petition footnote 5, page 8). According to the Cross-Petitioner, the Judd patent must be treated as prior art because Alexander is estopped to assert the truth or to enjoy the benefit of the fact that he is the first and only true inventor of the microseal process. As will be shown, the Cross-Petitioner is asking this Court to create a new species of estoppel in order to crown with success an attempt by Judd and 3M to defraud, which has been thwarted by both Courts below. For this purpose some reference to the historical background is necessary.

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[5] The Alexander patent issued from an application filed October 10, 1965. United States Plywood agrees (Cross-Petition, p. 21) that that application was a "continuation" of the prior application of February 20, 1965 (PX 1053, R 2934a-302a) and that the Judd application "had a later effective filing date" (Cross-Petition, p. 9, footnote 7). This concession that Judd has a later effective filing date is required by the provisions of 35 U.S.C. 120.

Historical Background

In the spring of 1954, General Plywood's George Alexander, who had been assigned the job of trying to develop a new and better way to treat the surface of wood, conceived, tested and disclosed to his co-workers the process which was later named the "microseal" process (R 1914a-6a, 2001a-2a, 2115a, 2146a-7a). The development of the process proceeded through consideration of the use of series of buffs operated on a band of contact across the width of an advancing panel (R 1980a-2a, 2118a), to the concept of using a suitable belt, such as a cork belt, on a wide belt machine under proper conditions. On April 7, 1955, Alexander fully divulged the conceived process, in confidence, to the person who could best be expected to supply Alexander with cork belt: Oliver Judd, the sales representative for General Plywood's supplier of coated abrasive products, Minnesota Mining and Manufacturing Company ("3 M") (R 78a-90a, 135a-7a, 1918a, 2119a, 2126a-7a; and see the opinion of the District Court at the bottom of R 44a).

Despite Judd's agreement to supply such a belt and repeated requests for that belt, it was not forthcoming, apparently because the belt material was not available in widths greater than 24 inches, as required for the General Plywood machines (R 2126a-7a). Finally, on May 18, 1955, under the pressure brought by General Plywood, Judd offered to run a test for Alexander on a 24" wide-belt machine which was owned by Reynolds Metals Company in the same city (Louisville) (R 84a, 2127a). As the trial court accurately stated "Alexander accepted Judd's offer in reliance upon the fact that, since GPC was a customer

of Judd and his employer, Judd was required to keep in confidence the information disclosed to him by Alexander and obtained in the experiment" (R 45a).

The test was run, General Plywood proceeded to fully explore and develop the invention, adapted it for its own commercial production and filed, on February 20, 1956, the first Alexander patent application (Serial No. 566,690), on the microseal process (PX 1053, R 2934a-42a and R 3057a, Col. 1, line 19). Subsequently, after a dispute over the terms of a proposed joint exploitation of the invention, 3M filed, on March 27, 1956, a patent application in Judd's name directed to the microseal process (R 3067a). The Judd patent issued on October 9, 1956 (R 3066a-3067a), in near record time.

The primary defect of the 3M patent was statutory: Judd "did not himself invent the subject matter sought to be patented."[*]

The second defect of the 3M patent was that Judd had failed to disclose essential features of the process in the patent (R 46a).

After full examination of both Alexander and Judd by deposition (R 114a) during which Judd presented a wholly incredible story of prior independent conception of the invention, the conflict with 3M was ultimately resolved, with 3M dedicating the Judd patent (DX 2002, R 3337a-8a; 157a).

Despite this background, United States Plywood, while never pleading or noticing the Judd patent as "prior art"

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[*] 35 U.S.C. 102 (f). The invention had been disclosed to Judd by Alexander and, as the Court held, Judd was bound to hold it in confidence (R 45a).

claimed (R 34a) that Judd was "prior inventor" of the process. Extensive depositions were taken,[7] which, coupled with the testimony of both Judd and Alexander at the trial (R 71a-195a; 2110a-71a) so thoroughly established that Judd's claim of inventionship was pure fabrication that the defense was not pressed before the Court of Appeals and is explicitly (Cross-Petition, p. 8, footnote 5) *not* advanced to this Court.

The Facts Bearing on the Alleged Estoppel

While it is not claimed by the Cross-Petitioner, United States Plywood, that the Judd patent is "prior" art in fact, the claim is made that the failure of Alexander to provoke an interference with Judd in the Patent Office creates as estoppel against Alexander which makes it necessary to treat the later filed, fraudulent and inaccurate disclosure by Judd of Alexander's invention as though it were part of the prior art. Neither of the Courts below found any such estoppel.

The file history of the Alexander application, Serial No. 615,127,[8] shows that in this case the Patent Office allowed the Alexander patent without ever giving notice under 35

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[7] Including, *inter alia*, Judd, Vols. I through IV, filed Dec. 4, 1962 (R 14a), Mohr, Vols. 1 and II filed Dec. 4, 1962 (R 13a), Zoeller, two Vols., filed Dec. 4, 1962 (R 13a), Horrar, filed Dec. 4, 1962 (R 14a), Baker, two Vols., filed Dec. 5, 1962 (R 14a).

[8] At the trial certified copies of the complete file histories of the two Alexander applications were offered and received in evidence. The earlier application, Serial No. 566,690, filed February 20, 1956 is PX Exhibit 1053, and the second application, Serial No. 615,127 filed October 19, 1956 is PX Exhibit 1054. The portion of the trial transcript showing

(Continued on next page)

U.S.C. 135 of the existence of any interference. Nor did the Patent Office require that Alexander copy claims from the Judd patent or contest an interference with Judd. This was no oversight because the file history shows that the matter was discussed at a conference between the Patent Examiner and the attorney for Alexander (R 3052a-53a). At that time Alexander's attorney expressed the view that no interference should be declared because the claims presented by Alexander differed materially from those of Judd. Apparently, that view was acquiesced in by the Examiner because he thereupon allowed the Alexander Patent. The Patent Office never suggested that the Judd patent was prior art, undoubtedly because Alexander was presumptively the first inventor on the basis of his earlier filing date.

There was no basis for an interference because Judd's claims failed to define essential features of the microseal process. They did not specify the step of compressing or densifying the wood surface and they erroneously specified the use of light pressure (R 3069a).

The claims which now appear in the Alexander patent were originally allowed in the earlier Alexander applica-

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(Continued from preceding page)

the receipt of these exhibits in evidence is printed in the Appendix hereto at A-8 and A-9. Portions of the early application PX Exhibit 1053 were printed in the joint Appendix to the briefs in the Court below (R 2934a-3020a, 3763a and 3861a-5a) and additional portions are printed in the Appendix hereto at A-1 to A-3. Portions of the second Alexander application PX Exhibit 1054 were printed in the joint Appendix to the briefs in the Court below (R 3020a-54a, R 3752a-54a and 3865a-7a) and additional portions are printed in the Appendix hereto at A-4 to A-7.

tion, Serial No. 566,690, filed February 20, 1956 (PX 1053, Appendix hereto A1-3, R 3015a-20a). They were transferred with minor amendments to the second Alexander application and claim 7 was allowed. Thus the possibility of further litigation between the *present parties* over claim 7 of the patent in suit was never rejected in that application.[9]

REASONS FOR REFUSING THE WRIT

The first Question presented in the Cross-Petition relates to the propriety of adjudging a patent valid when the patent is held not infringed. The question as stated fails to mention that the judgment on validity was rendered on a declaratory judgment complaint filed by cross-petitioner and it is based on the erroneous assumption that in view of the holding of non-infringement, there is no longer a controversy between the parties. The controversy continues to rage. As will be shown, the Courts have generally held that such a judgment may be entered under the circumstances of this case, and there is no conflict between the Circuits, as alleged in the Cross-Petition.

It can hardly be said that there is no controversy between the parties when Cross-Petitioner is also asking (Questions 2 and 3) that this Court review the holding of

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[9] The history of representative claim 7 of the Alexander patent may be traced as follows. It was originally inserted in the early Alexander application as claim 20 on May 20, 1957 (R 2969a-70a and A1-3). It was initially rejected, but eventually held patentable by the decision of the Board of Appeals (R 3015a-20a) rendered on Sept. 30, 1957 in the early application. Thereafter, on July 15, 1957, it was transferred to the later Alexander application as claim 15 (A4-5). It was never rejected in the second application although amended slightly as to form (A-6).

validity on its merits and Petitioner (in Docket No. 1351) is asking this Court to review and reverse the holding of non-infringement. In addition, because of the clear possibility of further litigation between the *present parties* over other variants of the accused process, Cross-Petitioner, United States Plywood, must not be left free to relitigate issues which have been exhaustively litigated and ruled upon by the Courts below.

There is no important public interest in the question other than the public interest in seeing an end to litigation after the parties have had their day in Court, and that interest can only be advanced by allowing the judgment of validity to stand. Finally, the basis of the question disappears if in response to the Petition in Docket 1351, this Court reviews this case and holds that the patent in suit is infringed by Cross-Petitioner.

Questions 2 and 3 in the Cross-Petition ask for a review, on the merits, of the findings of the Court's below that the patent is valid. As to both questions, the Cross-Petition alleges there is a conflict among the Circuits. The alleged conflicts do not exist. In addition, the Questions posed are based on assumptions not supported by the facts of the case. Questions 2 and 3 do not merit review by this Court on this record.

ARGUMENT

Question 1

The Judgment on Validity was Demanded by United States Plywood and was Exhaustively Litigated

United States Plywood asks this Court to strike the findings by both Courts below that the patent in suit is valid because, by reason of the holding of no infringement, there is no "actual controversy".

There was, is and will apparently continue to be an "actual controversy", and the facts of the case do not raise the question presented.

United States Plywood instituted this litigation by filing a declaratory judgment action demanding a judgment that the Alexander patent "and each and every claim thereof is invalid and void and that plaintiff's products and plaintiff's processes do not infringe said patent or any claim thereof" (R 23a). In the following years, United States Plywood undertook extremely extensive discovery proceedings pertaining to the validity and enforceability of the patent, including extensive and repeated Interrogatories (See, e.g., PX 1060-1064, R 3109a-3158a), and further including extensive depositions[10] at locations from Tennessee to Northern Minnesota and from New York to Los Angeles. It aggressively pursued every conceivable ground for challenging the validity of the patent. United States Plywood opened at the trial, as declaratory judgment plaintiff, and

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[10] The depositions instituted by United States Plywood extended for a total of approximately 70 days of actual deposition time and the transcripts thereof total over 8,500 pages.

the presentation of its direct case alone took over 21 trial days (R 1185a-6a). Over 28 separate, direct challenges to the validity of the patent were presented and argued by United States Plywood and challenges to the validity of the patent were extensively briefed to the trial court. All of the evidence, including evidence submitted by General Plywood in refutation of the presented challenges, was before the District Court, and that Court determined the patent to be valid.

United States Plywood again challenged the validity of the patent before the Court of Appeals for the Sixth Circuit, fully briefing and arguing the matter to the Court. The patent was again held to be valid.

Having demanded a judgment on the issue of validity, having exhaustively litigated that issue, thereby imposing an extraordinary burden on cross-respondent,[11] it now complains to this Court that the issue should not have been determined because there is no controversy.

There is a Continuing "Actual Controversy"

The controversy between parties on the issues of infringement has raged since prior to 1959. As is illustrated in DX 2083A and B (R 3559a-60a) United States Plywood has, at its several plants, frequently modified its rubbing speeds and pressures as well as the type of rubbing medium used. Accordingly, the likelihood existed at the trial that United States Plywood might well have practiced the pro-

[11] Both Courts below refused to allow recovery of costs (Cross-Petition SA-24 and SA-36). This can only be because of the massive but unsuccessful attack on the validity of the patent.

cess subsequent to the filing of the counterclaim, or practice it in the future, in a specific manner not before the Court, and the likelihood was expressly contemplated by the "Court Approved Stipulation Relating to the Scope of Adjudication" (R 38a-39a).

United States Plywood, itself, argues that it should be free to relitigate validity if subsequently sued on account of its use of variants of the processes accused in this case (Cross-Petition, p. 18). This argument is a tacit admission that United States Plywood has or expects to use processes other than those litigated in this case and fears the holding of non-infringement it has obtained may not be applicable.[12] In the context of the whole situation, this is more than enough "controversy" to support a declaratory judgment action and, therefore, sufficient to support the judgment rendered on validity.

It will further be observed that the actual controversy on the question of infringement, even by the specific United States Plywood operations which were litigated, continued through the Court of Appeals and yet continues today in the Petition, in Docket No. 1351.

The Alleged Conflict Among the Circuits Does Not Exist

With regard to Question 1, United States Plywood argues that this Court has, under the constitutional jurisdictional limitation, required the lower Court to delete an

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[12] Note that United States Plywood admittedly purchased cork belts at its Seattle plant for testing (R 2205a-6a) and it is clear from the opinions below that if such belts are used commercially in the practice of the process the Courts below would find infringement.

adjudication of validity in the absence of infringement, citing *Electrical Fittings Corporation v. Thomas and Betts Co.*, 307 U.S. 241 (1938) and further quotes this Court as having said "To hold a patent valid if it is not infringed, is to decide a hypothetical case", citing *Altvater v. Freeman*, 319 U.S. 359, 363 (1943). It then seeks to establish that "principle" as a basis of fundamental conflict between the "First, Second and Ninth" Circuits, which have allegedly followed it, and the "Sixth" Circuit, which allegedly has "passed squarely on this point in direct conflict with these holdings".

In its eagerness to rid itself of the fruits of its own demands in its declaratory judgment complaint, United States Plywood finds conflict where no conflict exists.

The cases relied upon have no bearing here since the controversy which prompted the declaratory judgment complaint in this case continues to rage. The situation is, therefore, quite unlike that in *Electrical Fittings*, where the patentee *accepted* the trial-court adjudication of non-infringement so that there was no longer a controversy in fact.[13]

The alleged "principle" quoted from the *Alvater* case was *not* the "principle" of that case but was a statement characterizing *Electrical Fittings* (and *Cover v. Schwartz*). But in *Altvater*, this Court explicitly held that the quoted statement did not apply, saying:

> "but the situation in the present case is quite different. We have here not only bill and answer but a

[13] Similarly, in *Cover v. Schwartz*, cited in the Cross-Petition, the parties *agreed* that there was no infringement so that, again, there was, by agreement, no controversy.

counterclaim. Though the decision of non-infringement disposes of the bill and answer, it does not dispose of the counterclaim which raises the question of validity." (319 U.S. at 363).

Thus, whether or not the alleged "principle" exists, it is not applicable to the facts of the case, and no conflict among the Circuits on *that* "principle" could influence the Court to grant the Cross-Petition in this case.

The Sixth Circuit is alleged to have passed squarely on "this point" directly in conflict with "these holdings." The fact is that the Sixth Circuit clearly follows a discretionary rule,[14] and has refused, where the circumstances rendered it appropriate, to consider the question of validity where no infringement has been found,[15] just as it has ruled on validity even though there was no infringement,[16] where circumstances rendered that course wise.

Similarly, the "First, Second and Ninth" Circuits have, contrary to the absolute position the Cross-Petition seeks

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[14] This Court, in *Sinclair and Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330 advised that it "will usually be the better practice" to inquire "fully into the validity of the patent."

[15] See, e.g., *Hazeltine Corp. v. Crosley Corp.*, 130 F. 2d 344, *American Seating Co. v. Ideal Seating Co.*, 124 F. 2d 70.

[16] Cases cited in the Cross-Petition, footnote 17, p. 13.

to establish, also followed a rule of discretion.[17] This is consistent with the accepted practice of deeming it to be within the sound discretion of the courts whether to accept jurisdiction of a declaratory judgment action (such as this is) at all.

There is no such conflict as the Cross-Petition alleges, and none requiring the intervention of this Court.

Perhaps the matter is best summarized by quoting the comments of the Court of Appeals in the present case:

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[17] The *First* Circuit *Hap Corp* case cited (p. 12, footnote 16) in the Cross-Petition for the contrary proposition explicitly states that whether the Court of Appeals should pass on validity after finding non-infringement "was perhaps a question of discretion, but one which we resolved in the negative". The *Second* Circuit *Addressograph* case relied on by United States Plywood is irrelevant since both the District Court and the Court of Appeals held the patent *invalid;* it discussed a prior case in which there was effective consent by the patent owner that there should be no ruling on infringement so that there was no controversy by agreement of the parties. The same situation existed in *Cover v. Schwartz* —there was no controversy *in fact.* The same Circuit later announced the noted rule of discretion in *Harris v. Air King Products Co.,* 193 F. 2d 158. The *Ninth* Circuit apparently also follows a rule of discretion since it does decree patents valid though not infringed where the circumstances render that action appropriate. See e.g., *Ernst v. Clemens et al.,* 185 F. 2d 231, in which the trial court's judgment that a claim was valid but not infringed was affirmed. In fact, in a recent (1965) decision on this question in *Canadian Ingersoll-Rand Co. v. Peterson Products,* 350 F. 2d 18, 26, that Court concluded that the existence of a counterclaim for a declaratory judgment on the issue of validity required a ruling on the question of validity even though no infringement was asserted as to those claims, and it determined those claims to be valid (reversing the trial court). Even more recently it refused to entertain an appeal from a judgment of noninfringement because the lower court had not ruled on validity in response to a counterclaim for declaratory judgment of invalidity. *Illinois Tool Works, Inc. v. Brunsing et al.,* April 28, 1967, 153 USPQ 771.

"While, as we will point out, the District Judge ultimately found non-infringement of this patent, we feel he was correct in passing squarely on its validity. The issues raised by cross-filed pleadings are complex. Validity is squarely attacked by the original plaintiff. And the case has involved a lengthy trial of complex facts, most of them bearing directly upon this issue. We believe ample precedent supports his passing on validity in the decree. *Sinclair Co. v. Interchemical Corp.*, 325 U.S. 327 (1945); *Altvater v. Freeman*, 319 U.S. 359 (1943); *Sparton Corp. v. Evans Products Co.*, 293 F. 2d 699 (C.A. 6, 1961), cert. denied, 368 U.S. 967 (1962). This controversy has no resemblence to a fictitious suit designed to achieve an advisory opinion. Cf. *Cover v. Schwartz*, 133 F. 2d 541 (C.A. 2, 1943), cert. denied, 319 U.S. 748 (1943)." (Cross-Petition, Appendix B, SA-19.)

Public Interest Does Not Require That The Judgment of Validity be Vacated

Cross-Petitioner sheds crocodile tears for the public and its competitors in its endeavor to escape the results of its day in court on the issue of validity. Neither the public nor any third party is bound by the judgment of validity. It binds only Cross-Petitioner. If that judgment is vacated without consideration on the merits of the question of validity, Cross-Petitioner can begin to use the cork belt recommended in the patent and if sued for infringement, could relitigate all of the grounds on which it attacked validity in the Courts below. It has had its very long "day" in court on these issues and should be bound by the resulting judgment.

Cross-Petitioner suggests that validity should not be determined independently of scope, but virtually all of the

grounds of attack on the validity of this patent have no bearing on the question of scope. For example, the contention that Judd was the inventor of the miscroseal process was exhaustively litigated in the District Court. Should United States Plywood have the right to relitigate that question? The public interest in having an end to litigation dictates a negative answer. Moreover, the judgment of validity does not preclude consideration of the scope of the patent in this or any future litigation between these parties.

The argument in the Cross-Petition that the public interest requires an invalid patent to be declared invalid but requires that a valid patent not be declared valid has no bearing on the posed question of the jurisdiction of a court to adjudge validity. Moreover, the argument is wholly invalid unless our entire patent system is contrary to public interest, because in the light of the Constitutional purpose and objective of the patent law, there is just as much public interest in judicial declaration of the validity of worthy patents as there is in the declaration of invalidity of those which are unworthy. In neither case is the judgment binding on third parties, but in each case, it is a beneficial guide to interested parties who must assess the patent.[18]

The argument that the judgment of validity has endowed General Plywood with a weapon which will be used "*in terrorem*", to deter competition, is emotional nonsense,

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[18] See the recent decision of the Court of Claims in *Technograph Printed Circuits, Ltd. v. United States, et al.*, 153 USPQ 298 (Feb. 17, 1967), which contains a full discussion of authorities on the effect of judgments in patent actions upon third parties.

totally unsupported by the record. It is possible that some malefactors are terrorized at the prospect of receiving their just reward, but it is far fetched to believe that a corporation can be terrorized by the prospect of paying reasonable compensation for its unauthorized appropriation of a validity patented and valuable invention and there is no reason for this Court to coddle such an infringer, if any exists. Further, there is evidence that General Plywood has sought to and has licensed the patent at a reasonable royalty (2032a-2033a, 3611a-12a, DX 2147A, R 3611a-12a, 2018a-19a, 2024a, 2028a-9a, DX 2056, Admission 41 by USP, R 3472a and 1447a), and none that any prospective licensee has been refused. Finally, the sole purported basis for the use of these scare tactics is a collection of newspaper clipping, etc., which, apart from failing to support the argument, are not exhibits, are wholly extra-legal, and are improperly presented to the Court.

Question 2

Question 2, as presented in the Cross-Petition, is as follows:

> "2. Has the Court of Appeals for the Sixth Circuit misconstrued the standard of patentability set in this Court's recent decision in *Graham v. John Deere Co.* (383 U.S. 1) in holding valid a patent on a wood buffing process which simply uses a prior-art polishing belt in a prior art machine to glossify a wood surface?"

It must first be observed that the question reflects the same irrelevant argument which led the Courts below to err on the question of infringement, namely that there is nothing patentable in the apparatus used to practice the process.

Whether the preferred (or any other) machine useable in the practice of the process is old or new and whether the preferred (or any other) rubbing belt is old or new is not determinative of the patentability of the *process*, for as this Court has said in *Cochrane v. Deener*, 94 U.S. 780 (1876):

> "The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence."[19]

The pervasive and persistent effort by United States Plywood Corporation to becloud that principle clearly contributed to the erroneous conclusion of the Courts below on the issue of infringement, and is continued in the subject Cross-Petition. The patent in suit is *not* a patent on a machine, and is *not* a patent on a "cork belt", a "10/0 belt" or any other kind of belt. It is a patent on a process —a process which is new and useful and which is being practiced by the accused infringer. Alexander took old tools and used them to perform a process which the world had never conceived to produce highly advantageous results which the world had never seen.

Secondly, the Question, whether interesting or not, is not raised by the facts of the present case, because the supporting argument is founded on the assumption that

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[19] And see 35 U.S.C. 100 (b) "The term 'process' means process, art or method and includes a new use of a known process, machine, manufacture, composition of matter, or material."

the Judd patent is "prior art". As pointed out at page 10 hereof, Cross-Petitioner, United States Plywood, concedes that the Judd patent is not in fact prior art and does not contend that Judd is a prior inventor of the process claimed by Alexander. Nonetheless, it argues that the Judd patent must be treated as prior art because Alexander is estopped to benefit from the admitted facts by reason of his failure to contest an interference with the Judd patent.

The complete answer to this assertion is that there is no obligation on the part of any applicant to provoke an interference with a patent. While the Statute, 35 U.S.C. 135, directs the Commissioner, when in his "opinion" an application for patent would interfere with an unexpired patent, to "give notice thereof" to the applicant and patentee, whereupon the issue of priority shall be determined by a board of interference examiners, the giving of such notice is obviously discretionary since the statute conditions the requirement upon the Commissioner being of the "opinion" that the application and patent "interfere." As this Court has said in *Ewing v. United States, ex rel, Fowler Car Co.*, 244 U.S. 1, 1917, of the similarly worded statute, RS 4904, Comp. Stat. 1913, 9449, the statute gives the Commissioner of Patents discretion to declare or not declare an interference and when he fails to do so, "there is no defeat of ultimate rights."

As the file history shows (See pages 13 and 14 hereof), the Patent Office allowed the Alexander patent without giving notice under 35 U.S.C. 135 of the existence of any interference. This decision by the Patent Office was justified by the difference between Alexander claims and those of Judd;

but, in any event, it leaves the "ultimate rights" of the parties undisturbed, and there is no estoppel.

The remaining "prior use" referred to in the Cross-Petition was of a cork belt on a wide belt machine to polish aluminum. This was not a "prior use" within the meaning of 35 U.S.C. 102 because it was a single experiment which was a complete failure, never revived (DX 2134, R 3581a, 2589a-90a, 1874a). Moreover, the microseal process cannot be practiced on metal because metals are not porous and cannot be densified by frictional heat and pressure (R. 1691a).

The fact is that the Court of Appeals did not "essentially disregard the test of obviousness" set forth by this Court in *Graham*. Conversely, it explicitly found the invention to be unobvious under the standard set forth in that decision (Appendix of Cross-Petition, SA-19).

One further comment is required. The allegations (p. 23) that since "the Judd patent has been dedicated", the "public is fully entitled to use it" is outrageous in view of the facts recounted on page 11 and 12 hereof. All that 3M did was dedicate to the public whatever rights it might have or appear to have by reason of its ownership of the Judd patent. It could not and did not purport to dedicate any property of Alexander and General Plywood. It is worth noting in this context that the settlement agreement between 3M and General Plywood by which 3M agreed to dedicate the Judd patent (DX 2050, R 3388a, 1266a) expressly reserved the right of General Plywood to sue for infringement of the Alexander patent 2,827,935 concerns which used belts purchased from 3M.

Question 2, as presented, is based on a fallacious assumption of law, and does not merit consideration by this Court in this case.

Question 3

Question 3, as presented in the Cross-Petition, reads as follows:

> "3. Has 35 U.S.C. 112 abrogated the rule of this Court expressed in *Halliburton Oil Well Cementing Co. v. Walker,* 329 U.S. 1 (1946), that an invention may not be validly claimed 'in terms of what it will do rather than in terms of its own physical characteristics?'"

This Question, again, represents an effort to lead this Court to indulge in an intellectual exercise. The Question, whether challenging or not, is not raised by the facts of the case. In the first place, the doctrine of the Halliburton case has no application to a process claim because a process is "an act or series of acts[20] and has no "physical characteristics" that can be defined. Secondly, the entire argument of Petitioner is based on the erroneous assumption that the Judd patent is prior art; it is asserted that the claim is functional at the "point of novelty" *over the Judd patent.* The entire argument is based on the assumption that some unsupportable and irrational extension of the doctrine of file wrapper estoppel renders the Judd patent "prior art". It is not, for the reasons stated in connection with Question 2, and the Question falls with the assumption.

On the merits, it should be observed that the process claims in suit are not so broad as to cover all ways of achieving the desired result, i.e., a densified and nib bonded surface. They specify that this result be achieved by

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[20] *Cochrane v. Deener,* 94 U.S. 780, 788.

frictional rubbing pressure carried out in a particularly defined manner. They spell out the exact nature of the process by which the desired result is achieved and thus, avoid the basis on which this Court criticized the apparatus claims in the Halliburton case. Moreover, they clearly comply with the provisions of 35 U.S.C. 112 that:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The remaining arguments presented by United States Plywood relate primarily to the meaning of the term "relatively nonabrasive" and an argument as to an alleged "no man's land", which can *only* exist if the user intentionally starts out to microseal, using *microsealing* (not sanding) conditions, with a rubbing medium which is slightly too abrasive for microsealing at the start of the operation. These arguments relate to "definiteness" and infringement, have no relevancy to the issue stated by the Question, and require no further discussion.

Question 3 in the Cross-Petition does not merit consideration by this Court.

CONCLUSION

For the reasons stated above, the Cross-Petition should be denied.

Respectfully submitted,

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APPENDIX

A-1

PX Exhibit 1053

File 3023

IN THE UNITED STATES PATENT OFFICE

Applicant: GEORGE E. ALEXANDER Division 67
Serial No: 566,690
Filed February 20, 1956 803 Ky. Home Life Bldg.
For: METHOD AND APPARATUS FOR TREATING WOOD SURFACES Louisville 2, Ky.

May 17, 1957

AMENDMENT "B"

Commissioner of Patents
Washington 25, D. C.

Sir:

In response to the Office action of March 7, 1957, please enter the following amendment:

Page 5, line 23, after the period (.) add—

It will be observed that these belts provide a flexible, frictional, relatively nonabrasive buffing or rubbing and somewhat yielding surface composed of non-metallic material. Since this material, in comparison with metal, is a relatively poor conductor of heat or a good heat insulator, it may be aptly described as a heat insulating material.

Cancel all claims and substitute Claims 16-24 as follows:

• • • • •

(PX 1053, p. 58)

20 (Claim 11 rewritten)

A method of treating wood, comprising: *providing* a product having a relatively smooth and flat porous wood surface; *moving* that product relatively along a predetermined path extending longitudinally through a transverse work plane; *moving* an endless flexible rubbing medium, having a yielding relatively

(PX 1053, p. 60)

nonabrasive frictional heat insulating rubbing surface, at a relatively high rubbing speed toward and away from said surface at and along said transverse work plane; *pressing* said rubbing medium with a backing member into firm intimate contact against said wood surface at and along said work plane; *controlling* the magnitude of the relative product speed through said work plane at a value providing rubbing contact of predetermined momentary order at successive areas of said wood surface; *and controlling* the magnitudes of the rubbing pressure against said surface and the rubbing speed relatively to the surface at values causing said medium, during its momentary time of contact with a given area of said wood surface, not only to generate frictional heat on said surface at the elevated temperature level required for momentarily heat plasticizing said wood surface along said work plane without plasticizing the underlying wood throughout its depth but simultaneously to pressure smooth and densify the surface wood without densifying the underlying wood throughout its depth.

21

The method of Claim 20 wherein: the second mentioned controlling step is performed with the magnitudes of said rubbing pressure and rubbing speed controlled to produce

plasticizing, smoothing and densifying without charring said surface wood.

22

The method of Claim 20 wherein: the second mentioned controlling step is performed with the magnitudes of said rubbing pressure and rubbing speed controlled to produce said plasticizing, smoothing and densifying without scorching said surface wood.

(PX 1053, p. 61)

PX Exhibit 1054

(Mail Div., Jul. 15, 1957, U. S. Patent Office)

Division 66
File 3062

IN THE UNITED STATES PATENT OFFICE

Applicant:	GEORGE E. ALEXANDER	Div. 33 or 66
Ser. No.	615,127	
Filed	October 10, 1956	803 Ky. Home Life Bldg.
For	METHOD AND APPARATUS FOR TREATING WOOD SURFACES	Louisville 2, Ky.
		July 12, 1957

AMENDMENT "A"

Commissioner of Patents
Washington 25, D. C.

Sir:

In response to the Office action of Jan. 17, please enter the following amendments:

• • • • •

(PX 1054, p. 80)

—1—

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Add Claims 11-19 as follows:

—4—

(PX Exhibit 1054, p. 83)

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15

A method of treating wood, comprising: *providing* a product having a relatively smooth and flat porous wood surface; *moving* that product relatively along a prede-

termined path extending longitudinally through a transverse work plane; *moving* an endless flexible rubbing medium, having a yielding relatively nonabrasive frictional heat insulating rubbing surface, at a relatively high rubbing speed toward and away from said surface at and along said transverse work plane; *pressing* said rubbing medium with a backing member into firm intimate contact against said wood surface at and along said work plane; *controlling* the magnitude of the relative product speed through said work plane at a value providing rubbing contact of predetermined momentary order at successive areas of said wood surface; *and controlling* the magnitude of the rubbing pressure against said surface and the rubbing speed relatively to the surface at values causing said medium, during its momentary time of contact with a given area of said wood surface, not only to generate frictional heat on said surface at the elevated temperature level required for momentarily heat plasticizing said wood surface along said work plane without plasticizing the underlying wood throughout its depth but simultaneously to pressure smooth and densify the surface wood without densifying the underlying wood throughout its depth.

(PX Exhibit 1054, p. 86)

U. S. Patent Office
Received
B 3543
Dec. 4 1957
Division 66

IN THE UNITED STATES PATENT OFFICE

Applicant: GEORGE E. ALEXANDER — Division 33 or 66
Serial No. 615,127
Filed October 10, 1956 — 803 Ky. Home Life Bldg.
For METHOD AND APPARATUS FOR TREATING WOOD SURFACES — Louisville 2, Kentucky

AMENDMENT "B"

Commissioner of Patents
Washington 25, D. C.

Sir:

Please enter the following amendments:

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(PX Exhibit 1054, p. 108)

Claim 15, line 3, before "relatively", insert—edgewise—

line 9, change "contact against" to—frictional engagement with—

line 10, after "surface", insert—to maintain a transversely extending band of rubbing contact therewith—

line 12, before "rubbing", insert—momentary—

lines 12 and 13, cancel beginning with "of" in line 12 through "surface;" in line 13 and substitute—time of the order of a fraction of a second for each inch of contact band width;

line 13, before "controlling", insert—correlatively—

line 19, cancel "momentarily"

(PX Exhibit 1054, p. 111)

Department of Commerce
United States Patent Office
Washington

NOTICE OF ALLOWANCE

Mailed
Dec 24 1957
Pat Div 66

The application for patent identified below has been examined and found allowable for issuance of Letters Patent.
Applicant—George E. Alexander

Title of Invention or Improvement—METHOD AND APPARATUS FOR TREATING WOOD SURFACES

Serial No.—615,127; Filing Date—October 10, 1956; No. of Claims Allowed—16; Examiner, I. Lisann.

With the allowance of the application the final fee becomes due. This fee is thirty dollars ($30) plus one dollar ($1) for each claim allowed in excess of twenty (20) and must be paid within 6 months from the date of this notice. Failure to remit the final fee will result in the patent being withheld from issue.

As a convenience in remitting this fee, use of the enclosed Form POL-85a is suggested. The final fee will not be received from anyone other than the applicant, his assignee or attorney, or a party in interest as shown by the records of the Patent Office.

If it is desired to have the patent issued to an assignee or assignees, an assignment, together with the fee for recording the same, must be filed in this Office on or before the date of payment of the final fee.

The patent will be issued and forwarded within approximately two months after receipt of the final fee.

By direction of the Commissioner.

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(PX Exhibit 1054, p. 123).

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Testimony of Charles Hemming

Vol. II—9

Mr. Crews: I offer in evidence a copy of the Alexander patent in suit, number 2,827,935, which is March 25, 1958, on an application filed October 10, 1956, as a continuation and part of an earlier application, later abandoned, serial number 56690, filed February 20, 1956, as PX 1052.

(Whereupon, Copy of Alexander Patent in Suit was Received and Marked by the Reporter as PX 1052)

Vol. II—10

Mr. Crews: I offer in evidence a certified photostatic copy of the Patent Office File History of the Alexander Abandoned Application, Serial No. 566,690, of which the patent in suit issued on a continuation of prior art application together with the arts cited by the application as PX 1053.

Mr. Blair: I have no objection to the offer of a certified copy.

• • • • •

(Whereupon, a Certified Photostatic Copy of the Patent Office File History of the Alexander Abandoned Application, Serial No. 566,690 was Received and Marked by the Reporter as PX 1053)

Mr. Crews: The File History shows that these patents were at least called to the Examiner's attention and that they were all before the Patent Office at the time.

Vol. II—11

I offer in evidence as PX 1054 a certified photostatic copy of the Patent Office File History of the Alexander Application from which resulted the patent in suit, No. 2,827,935, together with copies of the arts cited by the Patent Office and mentioned to the Patent Office during the prosecution.

Mr. Blair: May I see that, please?

(Mr. Crews Hands Document to Mr. Blair and then an off-the-Record Discussion Ensued between Mr. Blair and Mr. Crews)

Mr. Blair: Your Honor, we would like to have an opportunity to check these—this collection of the patents which are fastened in this file.

It will take some time. And subject to that, I have no objection to the offer.

By the Court: All right.

(Whereupon, a Certified Photostatic Copy of the Patent Office file History of the Alexander Application, Resulting in the Patent in Suit, No. 2,827,935 was Received and Marked by the Reporter as PX 1054).